



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | | | | | | | | | | | | |
|---|---------------|----------------------|---|------------------|----------|--|----------------------|--|----------|--------------|------|--|-----------|---------------|------------|-------|
| 10/541,075 | 06/29/2005 | Alberto Turrini | 58009-019900/US | 4904 | | | | | | | | | | | | |
| 7590 Greenberg Traurig Suite 400E 2450 Colorado Avenue Santa Monica, CA 90404 | | 12/28/2007 | <table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">JACKSON, BRANDON LEE</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3772</td><td></td></tr><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>12/28/2007</td><td>PAPER</td></tr></table> | | EXAMINER | | JACKSON, BRANDON LEE | | ART UNIT | PAPER NUMBER | 3772 | | MAIL DATE | DELIVERY MODE | 12/28/2007 | PAPER |
| EXAMINER | | | | | | | | | | | | | | | | |
| JACKSON, BRANDON LEE | | | | | | | | | | | | | | | | |
| ART UNIT | PAPER NUMBER | | | | | | | | | | | | | | | |
| 3772 | | | | | | | | | | | | | | | | |
| MAIL DATE | DELIVERY MODE | | | | | | | | | | | | | | | |
| 12/28/2007 | PAPER | | | | | | | | | | | | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,075

Applicant(s)

TURRINI ET AL.

Examiner

Brandon Jackson

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 9, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/29/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/8/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement filed 2/8/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "19" has been used to designate two elements in Fig. 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 1 is objected to because of the following informalities: "the femoral upright" should be "a femoral upright" in line 13. Appropriate correction is required.

Claim 3 is objected to because of the following informalities: "pp" should be deleted after "tibial uprights" in line 3. Appropriate correction is required.

Claims 1, 4-5, 9-16 are objected to because of the following informalities: The use of the term pin is indefinite because it is used to refer to several pins. Applicant should use different names for each pin in order to eliminate confusion.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "may comprise" in line 5 is indefinite, because it is unclear whether Applicant intends to claim features following "may comprise." Therefore, for

examination purposes the Examiner will assume that limitations following "may comprise" are not being positively recited and are not critical to the claimed invention.

Claim 4 recites the limitation "the first pin application" and "the second ones" in Lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason et al. (US Patent 7,060,045). Mason discloses an articulated joint (28) for a knee brace (10) to control femoral-patellar instability comprising a central support bracket (figs. 6A-6B) fixed to the patella area, a first central plate (109) comprising a first housing for interchangeable insert means and a second central plate (108) opposite the first central plate (109) that rest against the side of the knee and comprises a second

housing that passes transversally through the plate (108). The second central plate (108) is designed to accommodate a cursor support (114). A lever (110) is mounted to the inner surface of a femoral upright (12) and hinged to the second central plate (33) close to its center at point (103). The lever (110) comprises a slot (136) intercepted by a pin (144) that is integral with the cursor (114). The cursor (114) is integral with the bracket (figs. 6A-6B) and has the ability to slide into appropriate housing in the joint (28). The first and second plates (109, 108) move angularly in different ways since the first pin applications are different from the second ones. The first plate (108) is hinged to the femoral and tibial uprights (12, 14) by pins (29, 30). The second plate (109) is hinged in a diametrically opposite fashion than the first plate (108) on the same pins (29, 30). The cursor (114) linearly slides through the housing (121) of the second plate (108). The linear sliding is imparted by the lever (110) that rotates about pin (29) on which the second plate (108) is mounted to the femoral upright (12). Mason discloses the claimed invention except for the uprights being between the first and second plate or first plate being hinged to the outer sector of the femoral upright and the inner sector of the tibial upright. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to move the uprights to the inner or outer surfaces of the plates, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Allowable Subject Matter

Claims 9 and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to disclose the upper end of the lever being hinged on a pin to the upright.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mason et al. (US Patent 7,059,329).

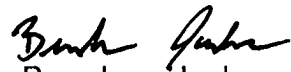
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Jackson whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

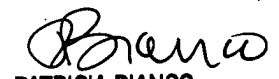
Application/Control Number:
10/541,075
Art Unit: 3772

Page 7

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 12/19/07
Brandon Jackson
Examiner
Art Unit 3772

BLJ


PATRICIA BIANCO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

12/21/07